

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-6 are presently pending before the Office, with claims 7-34 having been withdrawn from consideration due to a restriction requirement. No claims have been canceled. Applicants have amended the specification to correct a translation error and the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicants are not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed February 4, 2003 (Paper No. 14) and the references cited therein have been carefully studied by Applicants and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has objected to the Abstract and has requested that formulas be included. Applicants herein submit a new Abstract attached on a separate sheet.

The Examiner has requested that references be resubmitted as part of an IDS. The missing documents are resubmitted concurrently with this response. EP '495 is submitted as an English abstract along with another copy of its equivalent US. patent, which the Examiner has already considered.

Relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of claims 1-6 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner alleges that several terms are unclear and some terms are misspelled. Applicants respectfully traverse the rejection and request reconsideration.

Applicants submit that claims 1-6 do define the legal metes and bounds of the invention. It is not the role of the claims to enable one skilled in the art to reproduce the invention but rather to define, for those skilled in the art the legal metes and bounds of the invention. Nevertheless, in order to advance the case to allowance, the claims have been amended to clarify the terms deemed unclear or indefinite by the Examiner.

It is respectfully submitted that claims 1-6, as amended, fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 1 and 3 as being anticipated by Clough et al. Applicants respectfully traverse the rejection and request reconsideration.

Applicants respectfully submit that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The Clough patent fails this test. In fact, the Clough patent corresponds to JP Laid-Open 63-216848 Gazette and described in the specification of the present invention on page 2 and 3. Associated problems with the cited art is also described therein. In the cited reference, **the reaction was carried out in the presence of the base only such as NaH or NaOMe as a catalyst**. Applicants traced this prior art reaction conditions in Comparison Example 1 on page 109 of the specification of the present invention.

As mentioned in the specification, the process has a problem in the case where a compound containing a substituent "which causes side reactions in the molecule due to an existing base, such as methyl 2-[(2-isopropoxy-6-trifluoromethylpyridine-4-yl)oxymethyl] phenylacetate and methyl 2-chloromethylphenylacetate, the elimination or the dimerization of functional group at the side chain start ahead, thereby disturbing reactions for such formylation and alkylation." (See page 2 of the specification.) The present invention, on the other hand, uses a base and Lewis acid such as TiCl_2 as a catalyst to avoid the above side reactions.

Accordingly, each and every element of Applicants' claims have not been taught in that single reference. Applicants respectfully submit that claims 1-6 have not been anticipated by the Clough patent under 35 U.S.C. §102(b), and respectfully request that such rejection be withdrawn.

CONCLUSION

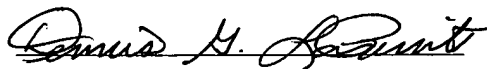
Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicants respectfully submit that claims 1-6 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 4/21/03



Dennis G. LaPointe
Mason Law, P.A.
17757 U.S. Hwy. 19 N., Suite 500
Clearwater, FL 33764
(727) 538-3800
Reg. No. 40,693